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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,192	01/02/2002	Pierre Delmas	EGYP 3.9-017 CONT	7042

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EXAMINER	
COUNTS, GARY W	
ART UNIT	PAPER NUMBER
1641	6

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,192	DELMAS ET AL.	
	Examin r	Art Unit	
	Gary W. Counts	1641	

-- The MAILING DATE of this communication app ars on th cov r sh et with th corr spond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 July 2002* .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-31* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 2, 10, 11,13-21,24, 29 and 30, drawn to a method for diagnosing or monitoring the evolution of a synovial disease, classified in class 435, subclass 7.92.

II. Claims 3, 5, 12 and 25, drawn to a method for monitoring the evolution of an osteoarticular disease, classified in class 436, subclass 501.

III. Claims 4 and 26, drawn to a method for determining a prognosis of evolution towards an osteoarticular disease, classified in class 435, subclass 7.1.

IV. Claims 6 and 27, drawn to a method for determining the efficacy of a drug administered to an individual for the treatment of an osteoarticular disease, classified in class 435, subclass 967.

V. Claim 7 and 28, drawn to a method for determining the toxicity associated with an osteoarticular or synovial disease of a drug intended to teat a disease, classified in class 435, subclass 975.

VI. Claim 8, drawn to a method for early diagnosis of an osteoarticular disease, classified in class 436, subclass 811.

VII. Claim 9, drawn to a method for diagnosing or monitoring synovial collagen degradation, classified in class 435, subclass 6.

VIII. Claims 22 and 23 drawn to a method for possible early diagnosis or for monitoring the evolution of an osteoarticular disease involving the degradation of synovial disease, classified in class 435, subclass 7.1.

IX. Claim 31, drawn to an antibody that can specifically recognize glucosyl-galactosyl-pyridinoline, classified in class 530, subclass 387.1.

2. Inventions I - VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed of as capable of use together and have different functions. Invention I is a method for diagnosing or monitoring the evolution of a synovial disease whereas Invention II is a method for monitoring the evolution of an osteoarticular disease and Invention I involves a reference level representing the absence of the disease and Invention II does not involve this limitation. Invention III is a method for determining a prognosis of evolution towards an osteoarticular disease or towards a predetermined stage in osteoarticular disease and involves the limitation of deducing a prognosis of evolution towards an osteoarticular disease or towards a stage in osteoarticular disease from that comparison and the other groups do not require this limitation. Invention IV is a method for determinining the efficacy of a drug administered to an individual for the treatment of an osteoarticular disease and involves bringing a biological sample from an individual under treatment into contact in vitro and also involves determining the degree of efficacy of the treatment and groups I-III and V-VIII do not require this limitation. Invention V is a method for

determining the toxicity associated with an osteoarticular or synovial disease of a drug intended to treat a disease and involves determining the degree of toxicity associated with a synovial or osteoarticular disease and groups I-IV and VI-VIII do not require this limitation. Invention VI is a method for early diagnosis of an osteoarticular disease and requires determining the actual presence of the osteoarticular disease. Invention VII is a method for diagnosing or monitoring synovial collagen degradation and involves a reference level representing the base or nomal level for synovial collagen degradation and also involves indicating normal or pathological degradation and the other groups do not require these limitations. Finally, Invention VIII is a method for possible early diagnosis or for monitoring the evolution of an osteoarticular disease involving the degradation of synovial disease and involves a specific marker which reflects the degree of synovial collagen degradation and the other groups do not require this limitation. The above listed inventions all have different purposes and are independent and distinct inventions.

3. Inventions I-VIII and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as the method of Invention I. The product could also be used in the materially different methods of inventions II-VIII.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for one group is not required for other restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary W. Counts whose telephone number is (703) 305-1444. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (703) 305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-4242 for regular communications and (703)3084242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Gary W. Counts
Examiner
Art Unit 1641
February 10, 2003

LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600
02/21/03